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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,904	03/22/2000	MARIE-PASCALE AUDOUSSET	05725.0545	7764

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EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
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1751

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/485,904	Applicant(s) AUDOUSSET, MARIE-PASCALE	
	Examiner Margaret Einsmann	Art Unit 1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 January 2004.
 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 16-40 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This action is in response to the petition decision mailed February 20, 2004 rescinding abandonment of this application. The response and Declaration under 35 USC 1.132 filed 11/10/03 have been entered.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/03 has been entered.

Since this application has been processed as an IFW application, it is necessary to provide a complete copy of the claims with each response, even if the claims have not been amended. Claims 16-40 are pending.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter

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as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terranova

Terranova, WO 97/49378, teaches compositions for dyeing hair which contain at least one pyrazolo[1,5-a]pyrimidine compound as oxidation base, which pyrazolo[1,5-a]pyrimidines encompass those as claimed, and wherein Terranova's preferred pyrazolo[1,5-a]pyrimidines include those as claimed, see page 3, line 7-page 4, line 19; and page 4, line 26-page 5, line 30. The pyrazolo[1,5-a]pyrimidines are present in the compositions in the claimed amounts, see page 8, lines 13-16. Terranova teaches and claims that the compositions may contain an additional oxidation base in the claimed amounts, wherein preferred oxidation bases include the claimed N,N-bis(- hydroxyethyl)-p-phenylenediamine, see page 9, line 24-page 10, line 9; page 11, lines 7-10; and claims 7-8. Terranova teaches that the compositions may also contain a coupler in the claimed amounts in order to modify the shades or enrich the glints, wherein preferred couplers include both m-aminophenols and m-phenylenediamines as claimed, see page 11, line 12-page 12, line 3. Terranova teaches that it is known in the hair dyeing art to mix oxidation base and couplers in order to obtain a wide range of colors, see page 1, lines 13-30. Terranova teaches processes of dyeing hair with oxidants as claimed, and teaches that the compositions may be packaged in kits as

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claimed, see page 13, lines 12-17; page 13, line 28-page 14, line 2; and page 14, lines 21-28. Terranova exemplifies various compositions which contain a mixture of a pyrazolo[1,5-a]pyrimidine oxidation base and coupler as claimed, wherein each component is present in the claimed amounts, and is applied to hair in a dyeing process as claimed, see Application Examples 2-5, 11-14, 21, 24 and 27. Terranova does not exemplify a dyeing composition, process or kit as claimed, particularly which contains or uses the claimed second oxidation base.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to formulate a composition for dyeing hair which contains a pyrazolo[1,5-a]pyrimidine first oxidation base, the second oxidation base N,N-bis(4-hydroxyethyl)-p-phenylenediamine, and a m-aminophenol or m-phenylenediamine coupler as claimed, wherein each component is present in the claimed amounts in mediums as claimed, wherein the compositions are applied to hair with an oxidant in a dyeing process as claimed, and are stored in kits as claimed, because Terranova teaches such compositions, processes and kits as preferred embodiments of the patentee's invention. Particularly, it would have been obvious to those skilled in the art to add the claimed second oxidation base to Terranova's exemplified compositions and processes identified above, resulting in compositions and processes as claimed, because the patentee teaches that this claimed additional oxidation base may be added to the patentee's compositions, and because Terranova teaches that it is known and conventional in the hair dyeing art to mix different oxidation bases and couplers in order to obtain a wide variety of colors, absent a showing otherwise.

Claims 16-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terranova in view of Brody, US 3,884,627.

Terranova, WO 97/49378 is relied upon as in the above rejection as teaching compositions containing applicants' first claimed oxidation base combined with m-aminophenol and/or m-phenylenediamine couplers as claimed, and suggests adding a second oxidation base chosen from conventionally known para oxidation bases as listed in the first full paragraph of page 10. Such list includes the claimed N,N-(bis-hydroxyethyl) p-phenylenediamine, as well as p-phenylenediamine and p-toluenediamine.

Brody is applied as teaching that the claimed N,N(bis-hydroxyethyl) –p-phenylenediamine was developed as a replacement for the above two para oxidation bases because of the need for oxidation bases to overcome the shortcomings of the above two bases. The disadvantages as listed in col 1 lines 48-64 of col 1 include insufficient resistance to shampooing, alkaline perspiration and light. Additionally, column 2 lines 50 et seq, states that N,N-bis(2-hydroxyethyl)-p-phenylenediamine is safe, that is less toxic than p-phenylenediamine or other structurally related compounds.

It would have been obvious to the skilled artisan to choose N,N(bis-hydroxyethyl)-p-phenylenediamine as the additional oxidation base in the compositions exemplified by patentee because of the advantages it provides over other conventional para oxidation bases, that is, it is safe, and Brody states at col 1 lines 59 et seq. that disadvantages of the prior art are eliminated by using his inventive compounds.

Response to Arguments and Declaration

Applicant's arguments filed 8/9/02 and 11/10/04 have been fully considered but they are not persuasive to overcome the above two rejections and accordingly they are maintained.

In the submission of 8/9/2002, applicant states;

A. The examiner has shown no motivation to modify Terranova. As stated above, the only modification needed is to add an additional oxidation base to the working examples. Terranova suggests the addition of the particular claimed second oxidation base. In the submission of 11/10/2003 applicant further states that the examiner has not shown any suggestion to modify Terranova with a reasonable expectation of success. In response to this argument, since Terranova himself suggests the modification, the examiner is not modifying the reference. Terranova's teaching of using the claimed second oxidation base as well as the claimed couplers is sufficient teaching to expect successful hair dyeing.

B. There is no motivation to select the specific combination of oxidation base as claimed. In response to this statement, patentee teaches the addition of the particular

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second oxidation base. See page 10 lines 4-11. Accordingly no motivation is needed.

Applicant further states in the response of 11/10/2003 on page 3 that Terranova teaches that his composition may optionally contain a second oxidation base and at least one coupler from a long list but one needs more than the general teaching of Terranova to arrive at the presently claimed invention. This reasoning is not understood. In the first place, Terranova's explicit teaching of the use of the claimed oxidation bases and couplers in combination is teaching that the combinations may successfully applied in combination. Additionally, applicant is invited to read the instant claims. Regarding claim 16, Applicant is invited to consider the list of couplers claimed. Every known meta-phenylenediamine couplers and most of the known meta-aminophenol couplers are claimed. Has applicant tested every composition claimed for evidence of improvement when used with each of the claimed first and second developers? Noting applicant's remarks on pages 3-5 of the remarks submitted 11/10/03, are all of these thousands+ of claimed compositions actually an improvement over the compositions of Terranova? The remarks of Terranova quoted on page 4 last paragraph disclose that Terranova teaches that his disclosed compositions meet the selected criteria. Note that he discloses the use of all of the claimed oxidation bases and couplers.

The Declaration under 37 CFR 1.132 filed 11/10/03 is insufficient to overcome the rejection of claims 16-40 based upon Terranova or Terranova in view of Brody as set forth in the last Office action because:

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A comparison must be commensurate in scope with the claims. One exemplification of the claimed composition will not overcome the rejection. Applicant is directed to M.P.E.P716.02 (d) and (e) for the requirements of comparisons which will overcome a prima facie case of obviousness. Objective evidence of unobvious results must be commensurate in scope with the claims. *In re Prater*, 162 USPQ 541; *In re Tiffin*, 172 USPQ 292; *In re Linder*, 172 USPQ 356; *In re Greenfield*, 197 USPQ 227.

Where unobvious results are relied upon as a basis for patentability, a proper comparative showing is a minimum requirement. *In re Eisenhut*, 114 USPQ 287.

Only one of each class of couplers is given, and only one of the claimed first oxidation bases is used. While Terranova does not give a working example of using the claimed first and second oxidation bases with a coupler, he certainly discloses the use of all of the bases claimed in claim 21 and all of the claimed meta aminophenol and meta phenylenediamine couplers as well as the use of the second claimed oxidation base.

Regarding the Results in the declaration on page 3 bottom, there also needs to be more explanation as to the relevance of the data presented. For example why is the delta E in the first comparison (Ex 1-2) only about 30% while the difference between the delta E in ex 3-4 is 300%?

Why has the L value in the first comparison doubled while the L value in the second comparison has increased 10%? How does one determine the significance of this data?

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Regarding the rejection of Terranova in view of Brody, Brody teaches that the claimed N,N(bis-hydroxyethyl) –p-phenylenediamine was developed as a replacement for the para oxidation bases because of the need for oxidation bases to overcome the shortcomings of known bases. The disadvantages as listed in col 1 lines 48-64 of col 1 include insufficient resistance to shampooing, alkaline perspiration and light. Additionally, column 2 lines 50 et seq, states that N,N-bis(2-hydroxyethyl)-p-phenylenediamine is safe, that is less toxic than p-phenylenediamine or other structurally related compounds. Accordingly, one would expect that the addition of the claimed N,N(bis-hydroxyethyl) –p-phenylenediamine, and the reduction of the amount of first oxidation base, would result in improvement in resistance to color degradation. In the examples in the declaration, Declarant replaces more than half or the first oxidation base with a base that is taught in the prior art to be resistant to shampooing, alkaline perspiration and light. Accordingly the results are not unexpected.

Double Patenting Warning

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

Applicant is advised that should claim 16 be found allowable, claims 17 and 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When

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two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). These claims do not further limit the composition of claim 16.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-Th and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12/27/04


Margaret Einsmann
Primary Examiner
Art Unit 1751